

Notice of Allowability

Application No.

09/481,126

Examiner

Harish T. Dass

Applicant(s)

ELLIOTT, DOUGLAS R.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/07/2006.
2. ☒ The allowed claim(s) is/are 1-6.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings have hand marked-up and some are not readable, the numbers on the drawing should correlated with specification. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Allowable Subject Matter

1. Claims 1-6 are allowed.
2. The following is an examiner's statement of reasons for allowance:

Prior art taken alone or in combination failed to teach or suggest the limitations of:

using at least one algorithm for assessing a value of the patent,
paying a monetary amount from said investment entity to said initial ownership of said patent upon transfer of title to a subsequent owner other than the original initial owner, and
granting at least one right under the patent to said initial owner of said patent, as recited in independent claim 1.

Prior art taken alone or in combination failed to teach or suggest the limitations of:

using at least one algorithm for assessing a value of the patent based, at least in part, on anticipated future use of the patent by the initial user,

using at least one algorithm for determining a cash flow stream containing at least one payment related to the assessed value of the patent,

paying, in at least one payment to said initial ownership, an amount related to the assessed value of the patent in the electronic database in exchange for transfer of title to said patent to a subsequent owner other than the initial ownership, and

granting a license to said initial user for the use of said patent from said subsequent owner in exchange for an agreement by said initial user to make at least one payment to the investment entity related to the assessed value of the patent at a specified time after the payment is made to transfer title, as recited in independent claim 2.

Prior art taken alone or in combination failed to teach or suggest the limitations of:

using at least one algorithm for assessing a value of the patent,

using at least one algorithm for determining a future cash flow stream related to the assessed value of the patent before the time title to the patent is acquired from the original ownership, and

granting a license to at least the original ownership to use the patent in exchange for an agreement to pay the future cash flow stream related to the assessed value of the patent, as recited in independent claim 3.

Prior art:

US 5,126,936 (Champion et al.) discloses a data processing system for managing a goal directed investment account, designed for individual and small institutional investors. More particularly, the present invention relates to a programmed controlled financial asset management system for implementing investor participation in capital markets through long and short positions in indexed investment vehicles.

US 6,018,714 (Risen, Jr. et al.) discloses a method of spreading the financial risks associated with the purchase, ownership and use of intellectual property, providing an insurance product which protects the value of intellectual property assets, insuring the validity of patents, trademarks, copyrights and other intellectual property, insurance for patents and other intellectual property in the context of acquisitions and mergers, providing protection against an unexpected change in value of an intellectual property asset, and providing compensation for an unexpected change in value of said at least one intellectual property asset.

NPL -

Reilly et al. "The valuation of health care intangible assets", Health Care Management Review, Gaithersburg, Spring 1997, Vol. 22, Iss 2; pg. 55, 10 pages – discloses several alternative methods for identifying appraising and estimating the remaining useful life of health care intangible assets.

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DeMatteis "From Patent to Profit Secrets & Strategies Fro The Successful Investor", Avery, 1998; ISBN 0-89529-79-1 – discloses licensing and types of licenses such as license to manufacture, sell and use, sale only license, manufacture only license, license to use, and exclusive license/non-exclusive license.

Each of the prior art taken alone or in combination failed to teach or suggest the above features recited in independent claims 1, 2 and 3.

Dependent claims 4-6 are allowed with same reason as of independent claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Claims 1-6 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Examiner
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5/31/07